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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,041	03/26/2004	Kazuya Matsumoto	17575	9537
23389 7590 11/14/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
SMITH, PHILIP ROBERT				
ART UNIT		PAPER NUMBER		
3739				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,041

Applicant(s)

MATSUMOTO ET AL.

Examiner

PHILIP R. SMITH

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) g is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) g is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 U.S.C. 112, Paragraph Two

- [01] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [02] Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- [03] Applicant recites a "magnetic-field generating means" and a "magnetic-field generating member" both of which generate a magnetic field. Applicant refers variously to "the magnetic field", but does not clearly indicate which magnetic field is being referred to.
- [04] Applicant recites "at least one magnetic coil which is driven on when the magnetic field is applied". To reiterate, it is not clear from what the magnetic field is emanating. Furthermore, it is not clear what is meant by "driven" - this could refer to the physical movement of the coil; the application of an externally generated magnetic field; or the application of current in order to generate a magnetic field.
- [05] Applicant recites the following paragraph:
- a magnetic-field generating member arranged in at least one portion of the capsule endoscope;
- wherein the magnetic-field generating member includes at least one magnetic coil which is driven only when the magnetic field is applied and when the magnetic field is not applied, generates a magnetic field, the magnetic-field generating means is controlled such that a magnetic field is intermittently applied as a pulse signal and the magnetic-field generating means drives the magnetic-field generating member in a time series manner and selectively to control the posture and movement of the capsule endoscope when the magnetic-field is applied; and
- [05b] Grammatical amendment is required for clarity. The following is recommended:

~~at least one magnetic coil~~ ~~magnetic-field-generating member~~ arranged in at least one portion of the capsule endoscope;

wherein the ~~magnetic-field-generating member~~ at least one magnetic coil is driven only when the magnetic field is applied and when the magnetic field is not applied, generates a magnetic field,

wherein the magnetic-field generating means is controlled such that a magnetic field is intermittently applied as a pulse signal and the magnetic-field generating means drives the ~~magnetic-field-generating member~~ at least one magnetic coil in a time series manner and selectively to control the posture and movement of the capsule endoscope when the magnetic-field is applied; and

- [05c] In addition to the above grammatical amendments, additional amendments are required to eliminate antecedence issues with "the magnetic field" and to clarify the meaning of "driven", as noted above.

Claim Rejections - 35 USC § 103

- [06] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [07] Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,681,260) in view of Biglieri (6,958,577).
- [08] Ueda discloses a capsule endoscope system comprising:
- [08a] a capsule endoscope ("capsule type endoscope 150," 18/8), of which movement is controlled by a magnetic field externally applied (via "guided part 159," 18/50);
- [08b] magnetic-field generating means ("magnetic force generating part 31," 18/45) for generating a magnetic field focused on one point to control the movement of the capsule endoscope traveling in a body cavity of a subject lying down on an examination table ("bed 10," 8/42-50); and

- [08c] moving means for moving ("magnetic force generating apparatus 11," 8/51-65) the magnetic-field generating means relative to the examination table;
- [08d] a magnetic-field generating member ("guided part 159," 23/18) arranged in at least one portion of the capsule endoscope, wherein the magnetic-field generating member includes at least one magnetic coil (23/17) which is driven when the magnetic field is applied (23/17-24), and when the magnetic field is not applied, generates a magnetic field (see below, "detecting the position of the guided part 159 with the hall sensor 131"), the magnetic-field generating means is controlled such that a magnetic field is intermittently applied (34/66-35/16);
- [08e] that the magnetic field may be intermittently applied as a pulse signal (see Figure 44 with reference to 25/1-6) and the magnetic-field generating means drives the magnetic-field generating member in a time series manner and selectively to control the posture and movement of the capsule endoscope when the magnetic field is applied ("a magnetic force is generated between this magnetic force generating part 31 and the guided part of the capsule type endoscope 150, the magnetic force generating part 31 is moved and the capsule type endoscope 150 is guided" 18/48-50).
- [08f] the position of the capsule endoscope is detected with the magnetic field generated by the magnetic field generating member itself ("By detecting the position of the guided part 159 with the hall sensor 131, the position of the capsule type endoscope 150 is detected," 18/43-51); the invention of Ueda is capable of position sensing when the magnetic field is not applied.
- [09] Ueda does not disclose:

[09a] moving means for moving the examination table relative to the magnetic-field generating means;

[10] Biglieri discloses the following in 5/23-30:

According to a further embodiment of FIG. 6, a magnetic structure may be provided which is displaced relative to the patient table, hence to the body under examination or the part thereof to a predetermined extent and in predetermined directions.

In this case, the magnetic structure 1 or the patient table 2, or both may be displaced relative to each other.

[11] Biglieri demonstrates the equivalence of the claimed invention with the invention disclosed by Ueda. At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the examination table disclosed by Ueda could be moved relative to the magnetic- field generating means disclosed by Ueda, as opposed to the other way around. A skilled artisan may turn to this obvious and equivalent alternative if, for example, the magnets (due to their weight) are more difficult to move than the patient; or if the wires associated with an electromagnetic field-generating device are short or cumbersome.

Response to Arguments

[12] Applicant's arguments filed 9/17/08 have been fully considered but they are not persuasive.

[13] Applicant contends that "Ueda merely discloses the change of the magnetic field when the capsule endoscope is made to pass through the large intestine". It is maintained that Ueda further discloses the capacities referred to above.

[14] Applicant contends that "Ueda is configured to transmit images in A field and to generate a magnetic field in B field. However, Ueda does not disclose or suggest that the magnetic field is applied as a pulse signal, and that position detection is performed when the magnetic field is not

applied." Applicant appears to concede that Ueda discloses that the magnetic field is applied as a pulse signal, and to contend that Ueda does not perform position detection is performed when the magnetic field is not applied. However, Ueda does disclose that there are periods when the magnetic field is not generated; and that a hall sensor may be used to sense position. The hall sensor may inherently be used during periods when no magnetic field is generated by the "magnetic force generating part 31".

- [15] Applicant concedes that "Ueda discloses that position detection is enabled with a hall sensor" but contends that "Ueda is not configured to apply the magnetic field as a pulse signal, control the posture and movement of the capsule endoscope when the magnetic field is applied, and detect the position of the capsule endoscope with the magnetic field generated by the magnetic coil itself when the magnetic-field is not applied, as is recited in the capsule endoscope system of claim 8". Applicant does not offer any support for this argument, and it is maintained that Ueda's device is inherently capable of controlling the posture of the capsule when the field is generated; and sensing its position when the field is not generated.

Conclusion

- [16] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- [17] A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the

mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- [18] Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILIP R. SMITH whose telephone number is (571)272-6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [19] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [20] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/

Examiner, Art Unit 3739

/Linda C Dvorak/

Supervisory Patent Examiner, Art Unit 3739